

REMARKS

As the Examiner is aware, the present application is concerned with adhesive tape products, specifically the kinds of products seen in households and in stationery applications. Such products generally consist of a long narrow strip having an adhesive on one side. This adhesive tape is wound up on a core and sold to consumers. The problem applicants are addressing is the problem of telescoping. In a telescoped roll of adhesive tape, each succeeding layer in the roll is slightly offset from the underlying layer. The roll of tape is no longer disk shaped. Rather, it is conical or cup shaped. Such a product is perceived by consumers as defective.

Claims 1-7, 9-10, and 16 are pending in the application.

In paragraph 4 of the Office Action, claims 1-[11]7, 9-10 and 16 are rejected as unpatentable over Schonhorn, et al. (0430548) in view of Rabuse (2,772,774).

In particular, claims 1-5, 9-10, and 16 were rejected by the Schonhorns reference alone. In the previous amendment, dated November 12, 2004, claim 1 was amended to recite a hollow cylindrical core and a length of adhesive tape wound upon that core. The length of tape comprises a leader portion fixed to the core, a foam support portion and a usable tape portion. The foam support portion is positioned after the leader portion and before the usable tape portion. The claim also recites a compressible foam strip fixed to the tape foam support portion. Schonhorn does not teach these structures. Rather, Schonhorn teaches modifying the core. In Schonhorn's first embodiment, the core is slit axially. This provides a gap extending from one edge to the other. In this way, the core is compressible. The body of tape is then wound upon this compressible core. In the second embodiment, the one relied upon in the Office Action, the collapsible core is achieved by enveloping the outer surface of the core with foam. The foam is glued to the core. The foam is on the order of 1-3mms thick.

The present rejection is not a new rejection but a revived previous rejection. Applicants amended claim 1 to include the limitation that "said foam support portion positioned after the leader portion and before said usable tape portion", as proposed by the Examiner on August 5, 2004 during a phone interview with the attorney of record. Applicants made the proposed amendment and are now perplexed as to the 35 USC 103(a) rejection applying the Schonhorn reference which had been previously applied and argued. Applicants in this present amendment, have revised the preambles of claims 1, 7 and 16 to read "[a]n anti-telescoping adhesive tape product" and request reconsideration of independent claims 1, 7, and 16, and all claims dependent therefrom.

Applicants' structure is different from Schonhorn. Applicants do not make the core

compressible. Rather, applicants add a layer of compressible foam to the tape which is then wound around the core. This uses the adhesive already on the tape to bind the foam in place. Applicants do not need to separately adhere the foam to the core. Thus, claim 1 recites a length of tape to form a leader which is attached to the core. Claim 1 also recites a foam support portion to which foam is attached which is then wound around the core. The claim then requires that the tape continue to a usable tape portion wound around the core and foam completing the product.

The Office Action acknowledges that Schonhorn fails to disclose a tape divided into a leader portion, a foam support portion and a usable tape portion. The Office Action asserts that Schonhorn teaches that the adhesive on the core serves the equivalent function as the leader portion and the foam support portion. Applicants respectfully disagree. The passage in Schonhorn pointed to in the Office Action (column 5, lines 4-6) merely recites that the foam body may be secured to the core by means of adhesive. This teaches nothing concerning the use of a tape to secure the tape and a foam strip in place wound upon the core. In applicants' invention, the foam strip is not adhered to the core. Rather, it is adhered to the portion of tape which it contacts. Thus, the Schonhorn passage points away from applicants' structure, not toward it.

The Office Action next points to the passage in Schonhorn starting at column 4, line 56 and finishing in column 5, line 1. That passage merely endorses the enveloping of the outer surface of a non-severed core with foam. It does not describe the advantages or the structure of applying an adhesive tape leader to the tape core, attaching a foam strip to a length of the adhesive tape and then wrapping the entire adhesive tape body around the core. Nothing in the reference suggests this structure or that this structure would be equivalent to adhering the foam directly to the core. It must be remembered that in the structure disclosed and claimed in claim 1, the adhesive strip is not adhesively bound to the core but is adhesively bound to the tape.

The section of the Office Action asserting that Schonhorn teaches the equivalent structure to claim 1, closes with the assertion that Schonhorn teaches the equivalent function of Applicants' anti-telescoping adhesive product. Applicants' respectfully disagree as the specific passages recited do not support the conclusion made. Schonhorn and the prior art do not show such equivalence.

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure of the mere fact that the components at issue are functional or mechanical equivalents. It appears that the Office Action is based upon a reading of Applicants' specification and use of these teachings to say that these structures are equivalent. Such a basis of rejection is improper under *In re Ruff*, 256 F.2d 590, 596, 118 USPQ 340, 346 (CCPA 1958). One may not use the teachings

of an application to establish equivalency of structures in a particular application. The equivalency of structures in addressing a particular problem must come from the prior art, not the application being examined. The Examiner has not demonstrated where the prior art has shown the functional equivalency of an adhesive and an adhesive tape portion. If the aforementioned were true, both the present application and Schonhorn would have very limited utility because both would be unnecessary in light of the many adhesives available.

The Examiner, in paragraph 5, states that Applicant in Figure 5 "discloses a core with a foam portion that is adhesively attached to the core". To the contrary, Figure 5 is a bottom view of the unrolled tape as seen in Figure 3 and illustrates the placement of the foam layer 14 on the adhesive tape.

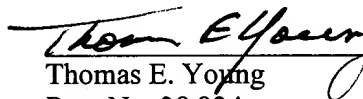
Claim 7 recites "a first portion of said tape adhering to said core, and useable tape portion wound in several turns about said core and said foam strip". Claim 16 recites "a length of adhesive tape directly attached to said core and wherein said foam strip is directly attached to said length of said adhesive tape". These structures are not obvious, nor suggested, in view of Schonhorn. It is respectfully submitted that claims 1, 7, and 16, and all claims dependent therefrom are allowable over Schonhorn for the reasons stated above.

It is respectfully requested that the Examiner reconsider and withdraw the rejection.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

April 7, 2005
Date


Thomas E. Young
Reg. No. 28,924
Karl W. Hauber
Reg. No. 52,999
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

☐ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT FEE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.

☒ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AMENDMENT BOX FEE, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

| |
|----------------|
| |
| Date 4-7-05 |

| |
|-------------------------------------|
| Signature <i>Adeline Machado</i> |
| Printed Name Adeline Machado |